

## REMARKS

### **I. Introduction**

Claims 16-19, 22-25 and 27-29 remain pending and rejected in the present application. Applicants respectfully request reconsideration of the pending claims.

### **II. Rejection of Claims 16-19, 22-25 and 27-29 under 35 U.S.C. § 103(a)**

Claims 16-20, 22-25 and 27-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,911,773 ("Mutsuga") in view of U.S. Patent No. 5,982,298 ("Lappenbusch"). Applicants respectfully submit that the rejection should be withdrawn for at least the following reasons.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, the Examiner must show, *inter alia*, that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references, and that, when so modified or combined, the prior art teaches or suggests all of the claim limitations. M.P.E.P. §2143. In addition, as clearly indicated by the Supreme Court, it is "important to identify a reason that would have prompted a person of ordinary skill in the relevant field to [modify] the [prior art] elements" in the manner claimed. See KSR Int'l Co. v. Teleflex, Inc., 82 U.S.P.Q.2d 1385 (2007). In this regard, the Supreme Court further noted that "rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." Id., at 1396. To the extent that the Examiner may be relying on the doctrine of inherent disclosure in support of the obviousness rejection, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art." (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

Independent claim 25 recites, in relevant parts, "a calculation unit configured to calculate a first route from a starting point to a destination, the calculation unit further configured to calculate at least one second route different from the first route, from the starting point to the

destination; a reproducing device configured to reproduce the calculated first route and the at least one second route for selection by a user; . . . [and] an input device configured to enable the user to manipulate or change at least one of the reproduced first and second routes by enabling the user to mark user-selected road segments on the reproducing device, the manipulated or altered routes including the user-selected road segments being selectable by the user for route guidance.” The claimed limitations at issue require the following: (1) calculating and displaying at least two different routes between the starting point and the destination; and (2) enabling the user to manipulate or change at least one of the reproduced first and second routes by marking user-selected road segments such that the manipulated or altered routes including the user-selected road segments are selectable by the user for route guidance.

In support of the rejection, the Examiner contends that “Mutsuga discloses an input device configured to enable the user to input data to manipulate or change the routes that is selected for guiding the user to travel from a starting point to a destination (see Figures 16-19).” Furthermore, the Examiner notes that while Mutsuga fails to disclose enabling “the user to mark user-selected road segments on the reproducing device, the manipulated or altered routes being selectable by the user for route guidance,” the Examiner contends that “Lappenbusch discloses an interactive traffic display and trip planner in which the input device which is the cursor control key is used to change at least one selected route by enabling the user [to] mark the selected road (see column 6, lines 14-37).” However, Applicants note that the Examiner’s contentions and the actual disclosures of the applied prior art simply do not support the obviousness conclusion, as explained in detail below.

First, to the extent the Examiner contends that “Mutsuga discloses an input device configured to enable the user to input data to manipulate or change the routes that is selected for guiding the user to travel from a starting point to a destination (see Figures 16-19),” Mutsuga does not teach or suggest the actual claimed limitation which requires manipulating or changing one of the previously calculated and reproduced first and second routes between the starting point and the destination; instead, Mutsuga merely teaches that the user may select desired route searching conditions to identify the optimal route that includes a desired facility on the way to the destination, but there is simply no suggestion in Mutsuga that previously calculated and reproduced route may be manipulated or changed.

Second, to the extent the Examiner contends that “Lappenbusch discloses an interactive traffic display and trip planner in which the input device which is the cursor control key is used to

change at least one selected route by enabling the user [to] mark the selected road (see column 6, lines 14-37)," once again the disclosure of the applied prior art is fundamentally unrelated to the claimed limitation which requires manipulating or changing one of the previously calculated and reproduced first and second routes between the starting point and the destination; instead, the cited portion of Lappenbusch merely discloses that road segments may be highlighted by moving the cursor control, for which highlighted road segments the current traffic description is provided, but the highlighting described in Lappenbusch has nothing to do with manipulating or changing one of the previously calculated and reproduced first and second routes between the starting point and the destination. In fact, the "trip planning mode" for calculating an optimal route between the starting point and the destination is described in a completely separate section of Lappenbusch, i.e., col. 7, l. 11-39, and there is no suggestion in any section of Lappenbusch that one of the previously calculated and reproduced routes between the starting point and the destination may be manipulated or altered by the user's marking of selected road segments.

In view of the foregoing explanation, Applicants submit that the overall disclosure of Mutsuga and Lappenbusch simply cannot support the obviousness rejection of independent claim 25. Accordingly, the rejection of claim 25 and its dependent claims 16-19, 22-24 and 27-29 should be withdrawn.

### III. Conclusion

In light of the foregoing, Applicants respectfully submit that all of the pending claims 16-19, 22-25 and 27-29 are in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,

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